

## IP Section Licensing Committee Meeting

Saturday, November 5, 2005 12:15 p.m. — 1:20 p.m.<sup>1</sup>

### MINUTES

**PARTICIPANTS:** Paul Alpern (Co-Chair; [paul@mips.com](mailto:paul@mips.com)), Lara Bliesner, Kevin DeBré (Co-Chair; [kdebree@ggfirm.com](mailto:kdebree@ggfirm.com)), Warren Dranit, Allison Malin (via telephone), and Tom Speiss (Secretary; [tspeiss@wccplaw.com](mailto:tspeiss@wccplaw.com)).

#### **I. Introductions**

Kevin DeBré asked each participant introduced him/herself and briefly describe their background. Most expressed a desire to share knowledge with other IP licensing lawyers. Ms. Bliesner and Mr. Dranit expressed a desire to join the Committee.

#### **II. Discussion of Ideas**

Because only a few Committee members were in attendance, DeBré said that he would postpone discussion of the agenda topics until the December 16 conference call. Instead, he facilitated a general discussion of the background of the Licensing Committee. This discussion included:

- How the Licensing Committee dovetails into all of the other standing committees; and
- The goals of the Licensing Committee, including: (1) a promotion and exchange of ideas and information of ideas; (2) monthly meetings and conference calls, which he mentioned will take place the third Friday of each month at 8:30 a.m.; (3) the formation of the Google Group (which is in place), and the formation of a discussion group and blog; and (4) networking among the members of the Committee, including the creation of a directory of members.

Lara Bliesner said that she is interested in working with the Licensing Committee in order to learn more about licensing, so that she could service long-standing business clients. Many of her clients are in the apparel industry.

Warren Dranit stated that he is a software engineer by trade. He said that he intended to use the Licensing Committee as a resource for licensing issues.

Paul Alpern said that he previously worked in Asia on licensing matters, and has served as in-house counsel in Northern California for the past five years. He stated that he is both eager and excited in assisting with the development of this Committee.

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<sup>1</sup> This meeting took place during the State Bar Intellectual Property Institute, held in Napa Valley, California.

Tom Speiss stated that he handles licensing litigation matters and royalties disputes, and is now handling licensing transaction matters. He echoed DeBré's and Alpern's comments, in that he wants to assist in building this Committee.

Allison Malin stated that she has been heavily involved in licensing matters — including software licensing.

Alpern stated that it is strong desire to work with the other members of the Committee in the creation, promotion and facilitation of an online discussion group. Dranit, a member of the IP Section Executive Committee provided Alpern with the names of the State Bar staff members who could assist him, including Mitchell Wood. Alpern asked Dranit whether the discussion boards should be moderated or non-moderated, and requested information regarding appropriate guidelines.

### **III. Young Lawyers Liaison**

DeBré stated that Lee Rawles, an attorney at the Los Angeles office of Paul Hastings, has volunteered to work as the young lawyers liaison for the Committee. Mr. Rawles can be reached at [leerawles@paulhastings.com](mailto:leerawles@paulhastings.com).

### **IV. Contemplated Committee Events**

DeBré stated that the Committee is planning ahead for events for next year. He said that through these events, the Committee can gain exposure within the State Bar.

In advance of the meeting, Speiss prepared a comprehensive list of recent and upcoming licensing seminars and conferences. A copy of the list was distributed to all in attendance, with the exception of Malin, who was participating by phone.

Other seminar topics that had been proposed previously include:

- The university and government licensing process;
- Licensing for in-house counsel; and
- How the Bayh-Dole Act will affect licensing. (Editor's Note: "The Bayh-Dole Act allows for the transfer of exclusive control over many government funded inventions to universities and businesses operating with federal contracts for the purpose of further development and commercialization." See <http://www.cptech.org/ip/health/bd/>.)

DeBré stated that he discussed the panning of events with Michael Krieger, Co-Chair of the Computer Law Committee. He added that Mr. Krieger: (1) said it is important to be fiscally responsible when planning events; and (2) suggested that the Licensing Committee partner with on of the other committees in the planning and promotion of its initial events. DeBré suggested that potential events could be planned in coordination with the Computer Law Committee or the Copyright Committee. He suggested taking up discussion of this matter during the December 16, 2005 Licensing Committee meeting.

Dranit stated that: (1) fiscal responsibility for events is a key component, but not a driver, adding that it is part of the consideration for planning an events; (2) standing committees such as the Licensing Committee are always better off partnering with another standing committee; (3) internal meetings should take place in a regular manner. He added that the Trademark Committee will sometimes have over 100 attorneys present on a lunchtime telephone conference. He said some of these calls regarded a formal topic, such as the USPTO electronic filing process.

DeBré then stated that, in addition to the suggestions previously mentioned, he believes that a Webinar can be utilized for Licensing Committee events. Power point slides used in such a presentation would be accessible to phone attendees through the Web.

Dranit stated that the Licensing Committee should also begin to think about topics for the IP Section's 2006 Annual Intellectual Property Institute, which will be held in Santa Barbara next October. He stated that he was in the process of planning a panel presently entitled "Intellectual Property on the Internet." He suggested that there may be licensing issues for Internet-related matters. He noted that planning topics for any meeting involves significant preparation.

Alpern stated that additional means for educating the members include: (1) Bulletin Boards; and (2) focused telephone conferences. He mentioned that some prominent law firms arrange an intra-firm conference call on a topic, and more than 100 attorneys from that firm will attend via telephone conference. He added that power point slides and "war stories" are effective methods of instruction.

Speiss stated that the Licensing Committee could also look into co-hosting events with local bar associations and national legal/trade organizations. Speiss, who practices in Los Angeles, suggested the Los Angeles County Bar Association, Beverly Hills Bar Association, the San Fernando Valley Bar Association and the Ventura County Bar Association. He mentioned the International Trademark Association and LIMA as examples of national legal/trade associations.

DeBré stated that the Beverly Hills Bar Association is an excellent example of a local bar association that has fantastic events. He also suggested that perhaps the Licensing Committee should focus on hosting events in local metropolitan areas, such as Los Angeles and Silicon Valley. He added his firm, Greenberg Glusker, would be receptive to hosting such an event.

## **V. Contemplated Committee Publications**

DeBré mentioned the recent book "*Trade Secret Litigation and Protection in California*," co-edited by Randall Kay and Rebecca Edelson of the Trademark Committee. He suggested that members of the Licensing Committee could publish articles on topics drawing upon recent deals and matters that they have handled and prepare a presentation on the article. He stated that, for example, he could author a short article on issues that arose during a sale and license-back of a trademark that he handled for a client in the hospitality

industry. Dranit suggested that another such article could be written regarding quality control in trademark licensing.

DeBré stated as an ambitious, but perhaps desirable goal would be to publish a compilation of such articles authored by Licensing Committee members.

Alpern stated that, initially, he would like to focus on the publication of articles, and the establishment of an online discussion board. He stated that the published articles should be made available to the Committee members.

## **VI. Members Directory**

DeBré stated that it has not been what information the Members Directory will contain. He suggested that it could contain: (1) contact information; (2) detailed industry background; (3) a link to that attorney's firm or corporate webpage; and (4) a link to the attorney's online biography. He then asked whether the Directory should be posted on the Licensing Committee Web page.

Dranit expressed concern that posting the Directory might lead to undesirable results, such as spam and headhunter calls. He suggested that this posting could be limited to members only access. He then asked what the benefits were to the posting.

DeBré stated that the benefits to posting include: (1) demonstrating the diversity of the Licensing Committee; and (2) encouragement to others to join, *i.e.* strength in numbers. Alpern added that it was a great way to network. For instance, he stated that if he has a question regarding apparel licensing, he will contact the attorney from the list that he knows handles this type of matter.

DeBré stated that, for now, he will continue to update the Members Directory, and include it in an e-mail to all members of the Committee.

## **VI. Next Licensing Committee Meeting**

The next meeting will be on **Friday, December 16, 2005 at 8:30 a.m.** DeBré encouraged all members of the Committee to participate. He stated that the meeting will last at the most one hour.

**Meeting adjourned.**